

## **REMARKS**

Claims 81-85, 87-89, 91-95, 97-99, 101-104, 107-110, 113, and 115-118 remain in the application. Claims 81, 87, 93 and 97 have been amended. Claims 86 and 96 have been cancelled.

### **I. The Amendments**

Independent claims 81 and 93 have been amended to include, as part of the multilayered thermoplastic film, at least one layer of a pressure sensitive adhesive overlying the second thermoplastic skin layer. Support for these amendments is found in cancelled claims 86 and 96. The dependencies of claims 87 and 97 have been amended in view of the cancellation of claims 86 and 96.

### **II. Claim Rejections**

**(A) Claims 81-85, 91-95, 101-104, 107, 108 and 113 have been rejected under 35 USC 103(a) as being unpatentable over Mueller U.S. 4,532,189 in view of EP 569,878.**

Reconsideration of the rejection of these claims is solicited in view of the amendments to independent claims 81 and 93, and the presence of at least one layer of pressure sensitive adhesive in the thermoplastic film of all of the above claims. In a previous amendment, these claims were amended to recite that the core comprises a light stabilizer at a concentration of about 1000 to about 10,000 ppm based on the weight of the core layer.

The Examiner has acknowledged that Mueller fails to teach (1) the core layer may comprise a light stabilizer at a concentration of about 1000 to about 10,000 ppm based on the weight of the core layer; (2) the first skin layer comprises a light stabilizer at a concentration of about 2000 to about 20,000 ppm based on the weight of the first skin layer; and (3) the second skin layer comprises a light stabilizer at a concentration of about 1000 to about 15,000 ppm based on the weight of the second skin layer. The Examiner also has acknowledged that Mueller fails to teach a pressure sensitive adhesive layer overlying a skin layer. (Communication of July 11, 2003, page 5).

EP 569,878 is relied upon by the Examiner for its teaching that a multilayer thermoplastic laminate consisting of a core layer containing not more than 0.5 weight percent UV absorber (stabilizer), with outer layers containing at least 1 percent UV absorber on at least one side can be used for glazing in construction applications, especially where the outer layer is exposed to sunlight.

The Examiner has concluded that it would be obvious to one of ordinary skill in the art at the time the invention was made, based on EP 569,878 to have included ultraviolet stabilizers into a core layer (e.g., in an amount of not more than 0.5 weight percent) and skin layers (e.g., in an amount of at least 1 weight percent) in a thermoplastic film of Mueller for use in applications where the outer layer is exposed to sun light.

Reconsideration of the above rejection is requested in view of (1) the amendments to independent claims 83 and 93 wherein the films have been defined as also containing at least one layer of a pressure sensitive adhesive overlying the second skin layer and (2) the fact independent claim 103 already recited the presence of at least one pressure sensitive adhesive layer. Neither of the references relied upon by the Examiner teach or suggest the presence of a pressure sensitive adhesive layer.

**(B) Claims 86, 87, 96 and 97 have been rejected under 35 USC 103(a) as being unpatentable over Mueller U.S. 4,532,189 in view of EP 569,878, as applied above, and further in view of Josephy et al U.S. 5,451,283.**

As noted previously, claims 86 and 96 have been cancelled, and the subject matter of claims 86 and 96 has been included in claims 81 and 93. Claims 87 and 97 have been amended to be dependent from claims 81 and 93, respectively. Thus, all of the claims pending in this application now recite the presence of at least one layer of pressure sensitive adhesive overlying the second skin layer.

All of the pending claims of the present application are directed to a multilayer thermoplastic film comprising a core layer, first and second skin layers as defined, and at

least one layer of pressure sensitive adhesive overlying the second skin layer of the multilayer film. Independent claims 81, 93 and 103 and the claims dependent therefrom also specify that the core layer contains 1000 to 10,000 ppm of a light stabilizer. The claims are not rendered obvious over the combination of Mueller '189, EP '878 and Josephy '283.

The Examiner has suggested, in the rejection of claims 86, 87, 96 and 97 that since Mueller teaches that "the multilayer film may be combined with other polymeric materials for specific applications", (column 4, lines 35-40), it would be obvious to add a pressure sensitive adhesive layer in view of Josephy et al, even though Mueller and EP '878 do not even mention adhesive layers. Josephy et al is relied upon by the Examiner for teaching that a multilayer thermoplastic film may be combined with a pressure sensitive adhesive and a release liner overlying the layer of pressure sensitive adhesive for making a multilayer film label stock.

Applicants respectfully request the Examiner to reconsider this rejection. Mueller's general teaching that his thermoplastic film "may be combined with other polymeric materials for specific applications" is so broad and general that it fails to provide a basis for the specific modification suggested by the Examiner. There is no teaching or suggestion in Mueller that it would be desirable to include a layer of any adhesive in his multilayer films, and there is no teaching in Mueller that would suggest the desirability of such a modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The only description of "other polymeric materials for specific applications" suggested by Mueller are that relatively thin layers may be added on either or both sides of the basic preferred three layer structure to improve seal strength or to lower gas and moisture permeability. No examples of polymeric compositions are given. Mueller's general teaching would include hundreds or even thousands of possible polymeric materials for various unspecified applications, and there is no teaching in Mueller that would lead one skilled in the art or the Examiner to a reference such as Josephy et al unless a person skilled in the art or the Examiner first read Applicants' patent application.

It is well established that even though the prior art can be modified, the prior art must have some suggestion of the modification. The only suggestion for incorporating a

layer of pressure sensitive adhesive on one of the skin layers is found in Applicants' written description and claims. The Federal Circuit has repeatedly warned that the requisite motivation must come from the prior art, not from what is taught by an Applicant for a patent. Mueller contains no suggestion or desirability of using an adhesive layer, and, as noted in In re Gordon, supra,

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.

Moreover, Applicants submit that it would not be obvious to combine the teachings of Mueller and Josephy since the two patents are directed to different technology. Mueller is concerned with polyethylene shrink films (see title and column 1, lines 7-10) for use in packaging films (column 1, line 9). Josephy '283 is concerned with oriented and annealed films which are not shrinkable and are useful in label manufacture. Accordingly, Applicants respectfully submit that all of the claims of the present application are patentable over the combination of Mueller '189, EP '878 and Josephy '189.

**(C) Claims 88, 89, 98, 99, 109 and 110 have been rejected under 35 USC 103(a) as being unpatentable over Mueller '189 in view of EP '878 as applied above and further in view of Schreck et al U.S. 5,716,898.**

The Examiner acknowledges that Mueller '878 fails to teach that the film further comprises an opacifying layer between the core layer and the second skin layer (claims 88, 98 and 109); and that the opacifying layer comprises a white pigment (claims 89, 99, 110). The Examiner relies on Schreck et al for their teaching that a thermoplastic packaging film can be made opaque by adding conventional opacifying pigments such as white pigments, and the Examiner concludes that because thermoplastic packaging films can be transparent or opaque as taught by the reference it would be obvious to one of ordinary skill in the art to have added pigments to at least one of the layers of the Mueller films. Reconsideration and withdrawal of this rejection is solicited since the modification proposed by the Examiner would destroy the intended function of Mueller's films. As acknowledged by the Examiner, Mueller's films are intended to be clear packaging films.

The addition of an opacifying layer or pigments to the films to make them opaque would render the films unsuitable for Mueller's intended use. It has been established that if a proposal for modifying the prior art in an effort to attain the claimed invention causes the prior art to become inoperative or destroys his intended function, then the requisite motivation for making the modification does not exist. In re Fritch, 972 F.2d 1260, 1265 n.12, 23 USPQ 2d 1780, 1783 n.12 (Fed. Cir. 1992).

Moreover, as noted above, claims 88, 89, 98, 99, 109 and 110 further distinguish over the combination of references in view of the presence of a layer of pressure sensitive adhesive. Since the multilayer films described in these claims are neither disclosed nor suggested by the combination of references, the rejection should be withdrawn.

**(D) Claims 115-118 have been rejected under 35 USC 103(a) as being unpatentable over Mueller '189 in view of Josephy '283.**

The Examiner notes that Mueller teaches that the heat-shrinkable thermoplastic film may be combined with other polymeric materials for specific applications. (See column 4, lines 35-40). However, the Examiner acknowledges that Mueller fails to teach that for some applications a layer of pressure sensitive adhesive overlies the second thermoplastic skin layer and a release liner overlies the layer of pressure sensitive adhesive.

It should be noted, that in addition to claims 115-118, claims 103, 104, 107-110 and 113 relate to an unoriented multilayer film comprising, inter alia, a layer of pressure sensitive adhesive. As noted above, and as acknowledged by the Examiner, Mueller fails to teach or suggest a pressure sensitive adhesive layer but relies on the teachings of Josephy to support a rejection based on obviousness.

Applicants respectfully submit that the above-identified claims which relate to unoriented films containing a layer of pressure sensitive adhesive are not obvious over the combination of Mueller and Josephy. As noted by the Examiner, Mueller teaches that the heat-shrinkable thermoplastic film may be combined with other polymeric materials for specific applications. In order to be heat-shrinkable, the film must be oriented. Accordingly, Mueller is not suggesting that the intermediate unoriented film which he prepares by coextrusion can be combined with other polymeric materials. Thus, for the

sake of argument, if it would be obvious to combine the teachings of Mueller and Josephy, one skilled in the art would add a layer of pressure sensitive adhesive to Mueller's oriented heat-shrinkable film, not the intermediate coextrudate which is unoriented.

Reconsideration and withdrawal of this rejection is requested.

### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this application.

Respectfully submitted,

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